

## R E M A R K S

Claims 1 - 26 were pending in the present application, claim 27 having been canceled on page 6 of the Preliminary Amendment filed September 7, 2000 with the Continued Prosecution Application.

Claims 14 - 21 have been canceled.

New claim 28 has been added.

Claims 1, 11, 12, 13, 22 and 28 are independent.

### Section 103(a) Rejections

Claims 1, 11 - 13 and 22 are rejected as being unpatentable over NcNatt et al. in view of Linnen et al. in view of Krauss. Claims 2 - 10, 14 - 21 and 23 - 26 are rejected as being unpatentable over NcNatt et al. in view of Linnen et al. in view of Krauss in view of U.S. Patent No. 6,026,370 to Jermyn. Applicants respectfully traverse the Examiner's Section 103(a) rejections.

#### Independent Claims 1, 11, 12, 13.

Each of independent claims 1, 11, 12 and 13 include the limitation that

*providing with the billing statement an offer to said individual to pay at least a portion of an amount due on said billing statement if said individual becomes a customer of said second entity*

None of the references cited by the Examiner disclose or suggest such a limitation. The Examiner intimates that it would have been obvious to provide such an offer with a billing statement from a first entity in order to decrease postage and provide increased revenue to the first entity. Office Action mailed August 2, 2000, page 7.

These motivations are not suggested by the prior art, and may not even be true motivations. It is unclear whether or how such a combination would increase revenue to the first party. It is further unclear whether the saving of postage would be a concern at all for the second entity, and if so whether it would be sufficient impetus for the second entity to enter such an arrangement.

Clearly, significant benefits of the present invention are completely unaddressed and unrecognized by the prior art. With the present invention, customers are more likely to view such offers provided with a billing statement, as opposed to the direct marketing-type mailings suggested by the Examiner. As described in the present application, offers sent via direct marketing is unlikely to even be read by customers, much less accepted. See, e.g., Specification, page 2, lines 8 - 14; page 2, lines 19 - 24; page 3, lines 23 - 24; page 5, lines 11 - 12; and page 6, line 28.

Further, in the present invention offers are presented in conjunction with a billing statement, which typically indicates a debt of the customer. An opportunity to reduce that debt may be presented as the customer is presented with the prospect of himself paying for that debt. Thus, customers are much more likely to accept such offers provided in accordance with the present invention. Specification, page 2, lines 19 - 24; page 5, lines 13 - 17; and page 5, lines 18 - 25. The prior art is devoid of any suggestion of this benefit, much less any solution that would permit the benefit to be realized.

**Independent Claims 14, 19, 20, 21.**

Claims 14 - 21 have been canceled to be pursued in a continuing application, rendering the rejection in the present application moot.

**Independent Claim 22.**

Claim 22 includes the following limitation:

*receiving an offer with the billing statement to have at least a portion of said amount due paid by a third party in exchange for becoming a customer of said third party*

Thus, claim 22 and those claims dependent thereupon, are patentable for at least the reasons discussed above with respect to independent claims 1, 11, 12 and 13.

**Official Notice**

On page 4 of the Office Action, the Examiner has taken Official Notice that the "use of the customer database of a competitor or a third parties [sic] as a resource for potential customers which is cross-checked with the business' own customer database is also well known". Applicants traverse this assertion, and request a reference in support of the officially noted material. Applicants are unaware of any art indicating that a customer database of a competitor may be so used.

On page 10 f the Office Action, the Examiner asserts that it is common for the second entity to provide the bill issuer with either a list of desired customers or else the criteria by which such customers are to be selected. Applicants traverse this assertion, and request a reference in support of the officially noted material. Applicants believe that the practice is for bill issuers to not select customers at all, but to give all customers the same material.

Finally, Applicants had requested a reference to support the Examiner's Official Notice on pages 9and 11 of the Preliminary Amendment filed September 7, 2000. Applicants reiterate this request.

**Amended Claims**

Claims 11 and 19 have been amended to correct obvious typographical errors. No amendment was made for a reason related to patentability.

**Newly Added Claim 28**

Newly added Claim 28 distinguishes over the references cited by the Examiner, alone or in combination, for the reasons stated above and for other reasons.

### Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

### Petition for Extension of Time to Respond

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. Please charge \$890.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



---

May 21, 2001  
Date

Dean Alderucci  
Attorney for Applicants  
Registration No. 40,484  
Alderucci@WalkerDigital.com  
Walker Digital Corporation  
Five High Ridge Park  
Stamford, CT 06905-1326  
203-461-7337/voice  
203-461-7300/fax



S P E C I F I C A T I O N A M E N D M E N T S  
P A T E N T & T R A D E M A R K O F F I C E M A R K E D U P F O R M

Please **AMEND** the paragraph beginning on page 1, line 4 as follows:

This application is a continuation-in-part of U.S. Patent Application Serial No. 08/982,149, filed December 1, 1997, now U.S. Patent No. 6,196,458, incorporated by reference herein.

**C L A I M   A M E N D M E N T S**  
**M A R K E D   U P   F O R M**

Please CANCEL claims 14 - 21.

Please AMEND Claim 11 as follows

11. (TWICE AMENDED) A customer acquisition system comprising:  
    a memory for storing a customer account record of a first entity, said customer account record including a customer identifier;  
    a processor operatively coupled to said memory, said processor configured to:  
        select a customer account record;  
        determine if an individual indicated by said customer identifier is a customer of a second entity;  
        generate a billing statement from the first entity for said individual; and  
        provide with the billing statement an offer to said individual to pay at least a portion of an account due on said billing statement if said individual becomes a customer of said second entity;  
        [means for receiving] receive acceptance of said offer from said individual; and  
        [means for acquiring] acquire the individual as a customer by transferring said at least a portion of said amount to the first entity by the second entity.

**NEW** claim 28 has been added.